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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,953	01/29/2004	Nicholas Paul MacMillan	0119/0032	2324
21395	7590	07/24/2007		
LOUIS WOO LAW OFFICE OF LOUIS WOO 717 NORTH FAYETTE STREET ALEXANDRIA, VA 22314			EXAMINER HALL, DEANNA K	
			ART UNIT	PAPER NUMBER
			3767	
			MAIL DATE	DELIVERY MODE
			07/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/765,953

Applicant(s)

MACMILLAN ET AL.

Examiner

Deanna K. Hall

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :August 13, 2004; October 18, 2005.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements (IDS) submitted on August 18, 2004 and October 18, 2005 are in compliance with the provisions of 37 CFR 1.97(b). Accordingly, the IDSs are being considered by the Examiner. However, the listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in **37 CFR 1.56**.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 recites the limitation "said aperture" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-8, 12-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (US 5,919,174). Hanson discloses a valve comprising:**

A housing defining a first bore 17 and a second bore 25; a valve member having a sealing surface 49 and being slidable in alignment with the first bore from a first position to allow fluid flow and to a second position to block fluid flow between the bores C4 L24-37.

A helical spring 31 arranged to urge the valve member to a second position C4 L24-28.

The valve member engages a tapered sealing formation 45 in the housing in the second position C4 L24-28.

A rod-shaped member 76 supports a cylindrical sleeve of resilient material 114 to provide a sealing surface to make a wiping seal with a bore 120 in the housing C6 L8-22.

Second bore 25 is inclined at an angle relative to the first bore; substantially 45 degrees C4 L11-15.

A rotatable locking member, cap 15 prevents movement of the valve member C4 L38-48.

The locking member includes a projection 57 movable into and out of alignment with the valve member so as to prevent or enable movement of the valve member C4 L38-46.

The housing has two walls and the locking member includes two projections that form a continuation of the two walls when the locking member is in a position to enable movement of the valve member, See Figs. 2-3.

The locking member 15 displaces the valve member by a short distance towards a sealing formation 37, 38 when the locking member is moved to its locked position C4 L24-28.

**7. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (US 5,919,174). Hanson discloses:**

A suction catheter 70, a suction control valve 11, a patient end manifold 82 which can be connected to a tracheal tube, and a flexible envelope 74 extending between the manifold and control valve, the suction control valve has a user-actuated member 15 for controlling opening and closing of the valve and is moveable substantially axially of the catheter from a forward, closed position to a rear, open position C4 L24-37.

**8. Claims 21-22 rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (US 5,919,174). Hanson discloses a valve comprising:**

A housing defining a first bore 17 and a second bore 25 adapted to be connected to a source of suction; a valve member slidable within the housing; a spring 31 operable to close the valve C4 L24-28 ; a manually engageable member 15 coupled with the valve member to open the valve C4 L28-31.

A locking member 15 which either enables or prevents movement of the valve member C4 L38-48.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson in view of Decloux et al. (US 5,320,328) ("Decloux").**

Hanson shows as discussed above. Hanson does not directly show a plate member arranged for manual engagement and slidably located in a channel extending along an outer surface of the housing. Decloux, in the analogous art, teaches a plate member 34 slidably located in a channel 24 on the outer surface of the housing.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Hanson with the plate member and external channel as taught by Decloux for another way to manually actuate the valve.

**11. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson in view of Decloux further in view of Steigerwald (US 3,828,982).**

The combination of Hanson and Decloux shows as described above.

Hanson/Decloux does not directly show walls protecting the plate member.

Steigerwald, in the analogous art, teaches a safety actuator with walls surrounding the actuator, see Fig. 3. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Hanson/Decloux with the walls as taught by Steigerwald for preventing inadvertent contact with the actuator when the valve is gripped.

**12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson.**

Hanson discloses the claimed invention except for the housing being made of transparent material. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to form the housing of transparent material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deanna K. Hall whose telephone number is 571-272-2819. The examiner can normally be reached on M-F 8:00am-4:30.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached at 571-272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deanna K. Hall  
Examiner  
AU 3767

dkh



LOAN H. THANH  
PRIMARY EXAMINER